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EXAMINER

DENTON, T

ART UNIT	PAPER NUMBER
3745	4

DATE MAILED: 04/01/99

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-21 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-21 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftperson's Patent Drawing Review, PTO-948
- ☐ Notice of Patent Application, PTO-152

SEE OFFICE ACTION ON THE FOLLOWING PAGES--

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DETAILED ACTION

Double Patenting

1. Claims 1-8, 11-14, 18-19 are rejected under the judicially created doctrine of double patenting over claim of U. S. Patent No. 5,740,670 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: an elongated inner liner, an elongated outer shell, and a spacer disposed between the outer shell and inner liner.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4,6,8-21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lulloff et al. (Lulloff)

Lulloff discloses a water jacketed exhaust pipe for marine engines comprising; an elongated inner liner having a tail end, said tail end defining a first inwardly tapered section (see Figure 5, the area around reference numerals 59,60), an elongated outer shell surrounding the liner about an elongate axis of the pipe, said shell having a tail end defining a second inwardly tapered section. (See the area around reference numerals 59,60), and a spacer (66) disposed between said outer shell and said inner liner for separating said shell from said liner to define a volume (59,62) therebetween, said spacer further defining at least one passageway (68) communicating said volume (59,62) with a second volume outside the pipe. Clearly the cooling fluid exiting the passageway (68) is deflected onto the inner liner. The inner liner and outer shell are substantially cylindrical. (See Figure 4) Note that the inwardly tapered sections are curved, and coned shaped. (See Figure 5)

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Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lulloff in view of design choice.

Lulloff discloses the invention as recited above, however, fails to disclose the relative sizes of the inner liner and outer shell such that an exit velocity of 1.5 ft per second is maintained. It is the examiners position that the claimed velocity would have been an obvious matter of design choice well within the level of ordinary skill in the art. Moreover, there is nothing in the record which establishes that the claimed sizes which produce the desired flow rate presents a novel or unexpected result. (See *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975)).

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lulloff in view of Shioa et al. (Shioa)

Lulloff discloses the invention, however, fails to disclose the exhaust pipes and spacer being constructed from stainless steel.

The patent to Shioa teaches that it is conventional to utilize stainless steel in the construction of exhaust systems. (See column 1 lines 26+)

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It would have been obvious to one having ordinary skill in the art at the time the invention was made, to have utilized stainless steel in the Lulloff exhaust as suggested by Shioa for its well known benefit of resisting corrosion.

8. Claim 1-4,6,8-21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schlusser in view of Lulloff.

Schlusser discloses a water jacketed exhaust pipe for marine engines including an inwardly tapered elongated inner liner, and an inwardly tapered elongated outer shell substantially as claimed. (See Figures 1-2)

Schlusser fails to disclose a spacer having at least one passageway therethrough.

Lulloff on the other hand, teaches that it is conventional in the exhaust art to utilize a spacer ring for the specific purpose of providing an annulus for the passing of cooling water therethrough.

It would have been obvious to one having ordinary skill in the art at the time the invention was made, to have utilized the spacer taught by Lulloff in the Schlusser exhaust, since the use of the spacer would have provided a rigid connection between the concentric pipes, a desirable improvement to the Schlusser device.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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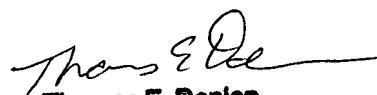
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Any inquiry concerning this communication should be directed to Thomas Denion at
telephone number (703) 308-2623.

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March 25, 1999


Thomas E. Denion
Primary Examiner